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09/927,890	08/10/2001	Gerald Jacino	1714-40	4787

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EXAMINER

PIAZZA CORCORAN, GLADYS JOSEFINA

ART UNIT

PAPER NUMBER

1733

DATE MAILED: 05/21/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/927,890

Applicant(s)

JACINO ET AL.

Examiner

Gladys J Piazza Corcoran

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 6.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Specification

1. The disclosure is objected to because of the following informalities: Page 4, line 22 recites, "2,8338,327" which should be --2,833,327--.

Appropriate correction is required.

Claim Objections

2. Claims 1-8 are objected to because of the following informalities:

Claims **1, 4, 6, 7, 8** all recite, "said inner surface flat including ridges". It is suggested to amend to either --said inner surface is flat and includes ridges-- or --said inner surface being flat and including ridges--.

Claims **1, 4 and 6** all recite, "including an adhesive surface layers and covered by release sheets". It is suggested to amend to --including adhesive surface layers covered by release sheets--.

Claim 4 recites, "including at least including an outer surface." It is suggested to amend to --including an outer surface--.

Claims **7, 8** all recite, "including an adhesive surface layers". It is suggested to amend to either --including an adhesive surface layer-- or --including adhesive surface layers--.

Claim 8 recites, "including the steps of translucent repair panel" which should be -- including the steps of, providing a translucent repair panel--.

Claim 8 recites, "as break" in line 8 and line 9-10, which should be --said break--.

Claim 8 recites, "lense" in line 7, which should be --lens--.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 7, 8 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claims 7 and 8 recite "said repair panel including an adhesive surface layers covered by a release sheet." The Specification only describes an embodiment where there is one adhesive layer on the repair panel with one release sheet (figure 12; page 8, lines 1-2) or multiple adhesive layers with multiple release sheets (figure 7; page 7, line 16). However, there is no disclosure of multiple adhesive layers with one release sheet. It is suggested to amend the claim to recite language as described in the specification.

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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6. Claims 2, 3, 4, 5, 7, 8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

7. Claim 2 is unclear by reciting, "said repair panel is selective colored." It is unclear what Applicant intends, whether the colored is selected by the user or the maker of the repair panel, or whether the panel has sections that are each colored selectively. Appropriate correction is required.

8. Claim 4 is unclear by reciting that the repair panel includes "a selection of inner surface portions." It is unclear what Applicant intends by this recitation. Does Applicant intend that there is more than one repair patch on the panel, or that there are different types of inner surfaces to select from. Clarification is required.

9. Claim 4 is unclear by reciting a translucent repair panel in line 2 with a clear surface in lines 5-6. It is unclear what Applicant intends by reciting a clear surface. If the repair panel is translucent it appears that the surface is clear. Clarification is required.

10. Claim 5 is unclear by reciting the repair panel includes a selection of grid patches. It is unclear what Applicant intends by this recitation. Does Applicant intend that there is more than one repair patch on the panel, or that there are different types of inner surfaces to select from. Clarification is required.

11. Claims 7, 8 are unclear by reciting, "said repair panel including an adhesive surface layers covered by a release sheet." The Specification describes an embodiment where there is one adhesive layer on the repair panel with one release

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sheet (figure 12; page 8, lines 1-2) or multiple adhesive layers with multiple release sheets (figure 7; page 7, line 16). It is unclear which embodiment Applicant intends.

Claim Rejections - 35 USC § 103

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

14. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Marshall (US Patent No. 5,569,346) in view of Butt (US Patent No. 6,106,648).

Marshall discloses a kit for repairing a break in an automobile lens or glass bulb housing (column 1, lines 5-10) including a translucent repair panel (patterned plastic column 3, lines 11-17), the repair panel including an inner surface and an outer surface where the inner surface is flat (plastic sheet), and the repair panel including an adhesive surface layer covered by a release sheet (column 3, lines 39-41).

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The repair panel in Marshall is a patterned plastic that can be patterned by tooling (column 3, lines 25-28), however Marshall does not specifically disclose that the tooled pattern is of ridges protruding outward forming a grid. It is well known to provide lenses and in particular repair patches for lenses with ridges protruding outward forming a grid in order to form the pattern. For example, Butt discloses a patch for repairing a break in an automobile lens where the patch has patterned inner surface that is flat with ridges protruding outward forming a grid that are formed by grooving/tooling (column 3, lines 20-23, 34-59). It would have been obvious to one of ordinary skill in the art at the time of the invention to provide the repair panel in Marshall with a pattern of ridges protruding outward forming a grid as is well known in the art when patterning a replacement patch for lenses by tooling as disclosed by Butt.

15. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Marshall in view of Butt as applied to claim 7 above, and further in view of Swallow.

The limitation that the repair panel includes an adhesive surface layers covered by a release sheet is unclear and not described in the Specification as discussed above. It appears as though Applicant intends to claim an adhesive layer covered by a release sheet as rejected in the paragraph above. However, the following rejection is directed to adhesive layers covered by a release sheet.

Marshall discloses an adhesive layer covered by a release sheet, however it is known in the adhesive art to provide multiple layers of adhesive covered by a release sheet in the repair patch art. For example, Swallow discloses a repair patch with two adhesive layers covered by one release sheet (column 7, lines 5-39). It would have

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been obvious to one of ordinary skill in the art at the time of the invention to provide the kit for repair as shown by Marshall with adhesive layers covered by one release sheet as it is known in the art as an equivalent alternative and exemplified by Swallow.

16. Claims 7, 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Marshall (US Patent No. 5,569,346) in view of Butt (US Patent No. 6,106,648) as further taken with Kobe et al. (US Patent No. 5,643,648) or Swallow (US Patent No. 5,820,958).

Marshall discloses a method of repairing a break in an automobile lens or glass bulb housing (column 1, lines 5-10) including the steps of providing a translucent repair panel (translucent thermoplastic patch; column 2, lines 24-31), the repair panel including an inner surface and an outer surface where the inner surface is flat (plastic sheet), measuring the repair panel over a break in said automobile lens or glass bulb housing (column 2, lines 1-5), cutting said repair panel to a size to overlap the break (column 2, lines 5-12), and engaging said cut repair panel over the break (column 3, lines 50-67).

The repair panel (translucent thermoplastic patch; column 2, lines 24-31) in Marshall has an inner flat surface with a patterned plastic that can be patterned by tooling (column 3, lines 25-28), however Marshall does not specifically disclose that the tooled pattern is of ridges protruding outward forming a grid. It is noted that the repair panel in Marshall has a separate plastic sheet adhered to the inner surface in order to provide the patterned inner surface. Currently, the claims do not exclude the repair panel from having a separate panel adhered to the repair panel for providing the inner

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surface. However, should applicant amend the claims to exclude an adhered panel, it would have been well within the purview of one of ordinary skill in the art to provide the patterned surface directly on the repair panel, only the expected results would be attained. For example, Marshall provides a separate patterned panel in order to custom fit the pattern to fit the hold being repaired, however it would have been well within the purview of one of ordinary skill in the art to provide the pattern directly on the repair panel in order to provide a quick repair with less method steps, particularly if a perfect custom fit were not required.

Although Marshall discloses the patterned plastic can be patterned by tooling (column 3, lines 25-28), Marshall does not specifically disclose the type of pattern and that the tooled pattern is of ridges protruding outward forming a grid. It is well known to provide lenses and in particular repair patches for lenses with ridges protruding outward forming a grid in order to form the pattern. For example, Butt discloses a patch for repairing a break in an automobile lens where the patch has patterned inner surface that is flat with ridges protruding outward forming a grid that are formed by grooving/tooling (column 3, lines 20-23, 34-59). It would have been obvious to one of ordinary skill in the art at the time of the invention to provide the repair panel in Marshall with a pattern of ridges protruding outward forming a grid as is well known in the art when patterning a replacement patch for lenses by tooling as disclosed by Butt.

The limitation that the repair panel includes an adhesive surface layers covered by a release sheet is unclear and not described in the Specification as discussed above. It appears as though Applicant intends to claim an adhesive layer covered by a release

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sheet as is rejected below in view of Kobe. However, the rejection below in view of Swallow is directed to adhesive layers covered by a release sheet.

Kobe:

Marshall adheres the repair panel over the break by applying bonding agent to the repair panel. It is well known in the repair art to provide patches for repair with pre-applied adhesive and a release sheet instead of applying bonding agents at the repair site in order to reduce the number of repair steps. For example, Kobe discloses a method of providing a repair patch with an adhesive surface layer covered by a release sheet prior to repair and then removing the release sheet during repair in order to overcome the difficulties of applying adhesive to the patch on site (column 1, line 28-47, 60-65; column 3, lines 15-24; column 9, lines 1-8). It would have been obvious to one of ordinary skill in the art at the time of the invention to provide method of repair as shown by Marshall by providing prior to repair adhesive on the repair panel with a release layer that is removed during repair as it is well known in the repair art in order to reduce the difficulties of adhesive application at the repair site as exemplified by Kobe.

As to claim 7, the references as combined above show a kit for repairing an automobile lens or glass bulb housing with a translucent repair panel (Marshall) with an inner surface with ridges protruding outward forming a grid (Butt) and an adhesive surface layer covered by a release sheet (Kobe).

Swallow:

Marshall adheres the repair panel over the break by applying bonding agent to the repair panel. It is well known in the repair art to provide patches for repair with pre-

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applied adhesive layers and a release sheet covering the layers instead of applying bonding agents at the repair site in order to reduce the number of repair steps. For example, Swallow discloses a method of providing a repair patch with adhesive surface layers covered by a release sheet prior to repair and then removing the release sheet during repair in order to overcome the difficulties of applying adhesive to the patch on site (column 1, lines 44-65; column 7, lines 5-39). It would have been obvious to one of ordinary skill in the art at the time of the invention to provide method of repair as shown by Marshall by providing prior to repair adhesive layers on the repair panel with a release layer that is removed during repair as it is well known in the repair art in order to reduce the difficulties of adhesive application at the repair site as exemplified by Swallow.

As to claim 7, the references as combined above show a kit for repairing an automobile lens or glass bulb housing with a translucent repair panel (Marshall) with an inner surface with ridges protruding outward forming a grid (Butt) and an adhesive surface layer covered by a release sheet (Swallow).

17. Claims 1-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Marshall (US Patent No. 5,569,346) in view of Butt (US Patent No. 6,106,648), Boyce (US Patent No. 2,833,327), and Swallow (US Patent No. 5,820,958).

(It is noted that this rejection is based on the patterned plastic layer of Marshall)

Marshall discloses a kit for repairing a break in an automobile lens or glass bulb housing (column 1, lines 5-10) including a translucent repair panel (patterned plastic column 3, lines 11-17), the repair panel including an inner surface and an outer surface

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where the inner surface is flat (plastic sheet), and the repair panel including an adhesive surface layer covered by a release sheet (column 3, lines 39-41).

The repair panel in Marshall is a patterned plastic that can be patterned by tooling (column 3, lines 25-28), however Marshall does not specifically disclose that the tooled pattern is of ridges protruding outward forming a grid. It is well known to provide lenses and in particular repair patches for lenses with ridges protruding outward forming a grid in order to form the pattern. For example, Butt discloses a patch for repairing a break in an automobile lens where the patch has patterned inner surface that is flat with ridges protruding outward forming a grid that are formed by grooving/tooling (column 3, lines 20-23, 34-59). It would have been obvious to one of ordinary skill in the art at the time of the invention to provide the repair panel in Marshall with a pattern of ridges protruding outward forming a grid as is well known in the art when patterning a replacement patch for lenses by tooling as disclosed by Butt.

Claims 1 and 6 recite the limitation that the repair panel includes a border separating the grid into two parts. Claim 4 recites the limitation that the repair panel include a selection of inner surface portions. Claim 5 recites the limitation that the repair panel includes a selection of grid patches. It is well known in the repair art to provide a repair kit with a repair panel that includes multiple patches for repair in order to give the customer choice in the size or shape of repair. For example, Boyce discloses a repair panel that provides plural repair patches separated by borders (column 1, lines 55-60; column 3, lines 4-38). It would have been obvious to one of ordinary skill in the art at the time of the invention to provide the repair panel in Marshall

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with a border or a selection of inner surface portions or grid patches in order to provide the user with multiple repair patches as is well known in the repair kit art and further exemplified by Boyce.

Claims 1, 4, and 6 recite the kit including a plurality of gasket strips including adhesive surface layers covered by release sheets. Marshall discloses an adhesive layer covered by a release sheet, however it is known in the adhesive art to provide multiple gaskets with adhesive layers covered by release sheets in the repair patch art. For example, Swallow discloses a repair patch with multiple gaskets with adhesive layers covered by release sheets (column 4, lines 1-36; column 7, lines 60-65). It would have been obvious to one of ordinary skill in the art at the time of the invention to provide the kit for repair as shown by Marshall with multiple gaskets with adhesive layers covered by release sheets as it is known in the art as an equivalent alternative and exemplified by Swallow.

As to claim 2, Marshall discloses the repair panel can be can be "selectively colored" (column 3, lines 15-18). As to claim 3, it would have been well within the purview of one of ordinary skill in the art to provide the gasket strips of translucent material particularly since the patch and the adhesive in Marshall must be translucent for the particular environment.

18. Claims 1-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Marshall in view of Butt as further taken with Swallow as applied to claim 7 above, and further in view of Boyce (US Patent No. 2,833,327).

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(It is noted that this rejection is based on the thermoplastic patch of Marshall a opposed to the patterned plastic layer of Marshall used in the rejection above)

Marshall discloses a kit for repairing a break in an automobile lens or glass bulb housing (column 1, lines 5-10) including the steps of providing a translucent repair panel (translucent thermoplastic patch; column 2, lines 24-31), the repair panel including an inner surface and an outer surface where the inner surface is flat (plastic sheet), measuring the repair panel over a break in said automobile lens or glass bulb housing (column 2, lines 1-5).

The repair panel (translucent thermoplastic patch; column 2, lines 24-31) in Marshall has an inner flat surface with a patterned plastic that can be patterned by tooling (column 3, lines 25-28), however Marshall does not specifically disclose that the tooled pattern is of ridges protruding outward forming a grid. It is noted that the repair panel in Marshall has a separate plastic sheet adhered to the inner surface in order to provide the patterned inner surface. Currently, the claims do not exclude the repair panel from having a separate panel adhered to the repair panel for providing the inner surface. However, should applicant amend the claims to exclude an adhered panel, it would have been well within the purview of one of ordinary skill in the art to provide the patterned surface directly on the repair panel, only the expected results would be attained. For example, Marshall provides a separate patterned panel in order to custom fit the pattern to fit the hold being repaired, however it would have been well within the purview of one of ordinary skill in the art to provide the pattern directly on the repair

panel in order to provide a quick repair with less method steps, particularly if a perfect custom fit were not required.

Although Marshall discloses the patterned plastic can be patterned by tooling (column 3, lines 25-28), Marshall does not specifically disclose the type of pattern and that the tooled pattern is of ridges protruding outward forming a grid. It is well known to provide lenses and in particular repair patches for lenses with ridges protruding outward forming a grid in order to form the pattern. For example, Butt discloses a patch for repairing a break in an automobile lens where the patch has patterned inner surface that is flat with ridges protruding outward forming a grid that are formed by grooving/tooling (column 3, lines 20-23, 34-59). It would have been obvious to one of ordinary skill in the art at the time of the invention to provide the repair panel in Marshall with a pattern of ridges protruding outward forming a grid as is well known in the art when patterning a replacement patch for lenses by tooling as disclosed by Butt.

Claims 1 and 6 recite the limitation that the repair panel includes a border separating the grid into two parts. Claim 4 recites the limitation that the repair panel include a selection of inner surface portions. Claim 5 recites the limitation that the repair panel includes a selection of grid patches. It is well known in the repair art to provide a repair kit with a repair panel that includes multiple patches for repair in order to give the customer choice in the size or shape of repair. For example, Boyce discloses a repair panel that provides plural repair patches separated by borders (column 1, lines 55-60; column 3, lines 4-38). It would have been obvious to one of ordinary skill in the art at the time of the invention to provide the repair panel in Marshall

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with a border or a selection of inner surface portions or grid patches in order to provide the user with multiple repair patches as is well known in the repair kit art and further exemplified by Boyce.

Claims 1, 4, and 6 recite the kit including a plurality of gasket strips including adhesive surface layers covered by release sheets. Marshall adheres the repair panel over the break by applying bonding agent to the repair panel. It is well known in the repair art to provide patches for repair with gaskets that have pre-applied adhesive layers and release sheets covering the layers instead of applying bonding agents at the repair site in order to reduce the number of repair steps. For example, Swallow discloses a method and kit for providing a repair patch with multiple gaskets including adhesive surface layers covered by release sheets prior to repair in order to overcome the difficulties of applying adhesive to the patch on site (column 1, lines 44-65; column 4, lines 1-36; column 7, lines 60-65). It would have been obvious to one of ordinary skill in the art at the time of the invention to provide kit6 for repair as shown by Marshall by providing prior to repair multiple gaskets with adhesive layers covered with release layers as it is well known in the repair art in order to reduce the difficulties of adhesive application at the repair site as exemplified by Swallow.

As to claim 2, Marshall discloses the repair panel can be can be "selectively colored" (column 3, lines 15-18). As to claim 3, it would have been well within the purview of one of ordinary skill in the art to provide the gasket strips of translucent material particularly since the patch and the adhesive in Marshall must be translucent for the particular environment.

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Double Patenting

19. Applicant is advised that should claim 1 be found allowable, claim 6 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gladys J Piazza Corcoran whose telephone number is (703) 305-1271. The examiner can normally be reached on M-F 8am-5:30pm (alternate Fridays off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Ball can be reached on (703) 308-2058. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.


Gladys J Piazza Corcoran
Examiner
Art Unit 1733

GJPC
May 18, 2003